

Application No. 10/713,643

REMARKS

Rejections under Section 112.

Applicant has amended claim 20 as indicated above. The claim is explicitly supported by the last sentence in paragraph [00136].

Regarding claim 13, Applicant has removed the term “triangular” as a claim limitation. The claim may cover any type of corner including square, triangular, trapezoidal, etc.

Regarding claims 11, 15, 16-20, and 24, Applicant has amended the claims in view of the comments set forth in the Office Action. Reconsideration and withdrawal of all Section 112 rejections is requested.

Rejections under Section 102.

According to the Office Action, claims 1-8, 10-12, 16-19, 22, and 23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,277,112 to Underwood et al. (hereafter “Underwood”).

Applicant has amended the independent claims 1 and 16. Amended claims 1 and 16 recite that an electrical connector extends through the shaft and terminates proximal to the screen. In contrast, Fig. 11 of Underwood shows the ends or terminals of the wire connectors extending beyond the support member and through (and distal to) the screen. The screen is press-fit onto the ends of the electrical connectors.

In contrast to Underwood, the above amended claims recite that the electrical connector terminates proximal to the screen electrode and that another member or agent is used to mechanically hold and electrically couple the screen electrode to the electrical connector. This is not disclosed in Underwood.

Based on the foregoing, reconsideration and withdrawal of the rejections based on Underwood is respectfully requested.

The other claims rejected under Section 102 and based on Underwood depend from claims 1 or 16 and consequently, are also not anticipated. Reconsideration and withdrawal of all the claims rejected under Section 102 is requested.

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Rejections under Section 103.

According to the Office Action, claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Underwood in view of U.S. Patent No. 5,944,715 to Goble (hereafter "the '715 patent). Applicant respectfully disagrees.

According to 35 U.S.C. § 103(c)(1) "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

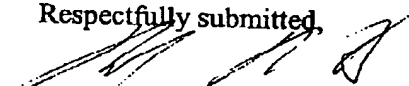
In the instant case, the claimed invention and Underwood were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. In particular, the claimed invention is under an obligation of assignment or owned by ArthroCare Corporation and Underwood is owned by ArthroCare. Accordingly, Applicant submits Underwood may not be used in a Section 103 rejection.

Removing Underwood as a prior art reference in a 103 rejection removes the primary reference being applied in the rejection. Accordingly Applicant submits that a proper prima facie case of obviousness has not been made. Reconsideration and withdrawal of the Section 103 rejection is respectfully requested.

CLOSING COMMENTS

Applicant has made a sincere effort to address all issues raised in the Office Action. Should the Examiner wish to discuss this matter with Applicant by telephone, he is urged to contact the undersigned at the below listed number.

Respectfully submitted,



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